REMARKS

This communication is a full and timely response to the final Office Action dated June 24, 2009. Claims 1-11, 13-23, 26-44, 46, 47, 49-57, 59-78, 80, 81, 83-90, 93-112, 114-125, and 127-140 remain pending, where claims 12, 45, 79, and 113 were previously canceled. By this communication, claims 24, 25, 48, 58, 82, 91, 92, and 126 are canceled without prejudice or disclaimer of the underlying subject matter, and claims 1, 8, 9, 11, 17, 21, 26, 35, 50, 59, 65, 68, 84, 93, 102,109, 118, 127, 136, 138, and 140 are amended.

In an interview conducted on October 23, 2009, Applicant's Representative and the Examiner discussed the After-Final Amendment filed on August 25, 2009 in light of the prior art of record. Although no agreement was reached Applicant's believe that the substance of this response places the instant application in a favorable condition towards allowance, based on the interview results.

On page 3 of the Office Action, claims 2-7, 9-11, 13-34, 36-40, 42-44, 46-67, 69-70, 72-74, 76-78, 80-101, 103, 104, 106-108, 110-112, 114-135 and 137-140 are rejected under 35 U.S.C. §112, second paragraph, for alleged indefiniteness. Applicants have amended the claims were applicable in an effort to address the above-stated concerns. Withdrawal of this rejection is respectfully requested.

Beginning on page 4 of the Office Action, Applicants claims stand variously rejected under 35 U.S.C. §103. Particularly, in numbered paragraphs 7-28, claims 1-6, 8-11, 13-16, 27-34, 35-39, 41-44, 49, 60-67, 68-73, 75-78, 80-83, 94-101, 102-107, 109-112, 114-117, 133-140 are rejected as allegedly being unpatentable over Applicants' admitted prior art (*AAPA*), *Katinsky et al* (U.S. Patent No. 6,452,609), *Thompson et al* (U.S. Patent Publication No. 2002/10077900) and *Portuesi et al*

(U.S. Patent No. 6,774,666); in numbered paragraphs 29-30 claims 7, 40, 74 and 108 are rejected for alleged unpatentability over AAPA, *Thompson*, *Portuesi* and *Katinsky*, and further in view of *Abato et al* (U.S. Patent No. 6,513,069); in numbered paragraphs 31-41 claims 17-26, 50-59, 84-93, and 118-132 are rejected as allegedly being unpatentable over AAPA, *Thompson*, *Portuesi* and *Katinsky*, and further in view of *Smith* (U.S. Patent No. 6,448,986). Applicants respectfully traverse these rejections.

Independent claim 1 is amended to include the subject matter previously recited in claim 25. Independent claim 1 recites the following:

> A method for playing full screen video on a user computer comprising:
> displaying in a user interface at said user computer a web page containing at least one link to an electronic video file;
> selecting said link to request said video file;
> downloading said video file to said user computer in response to said request;
> detecting by said user computer an initial receipt of said video file, wherein said detecting includes determining a display mode of the video file;
> opening in said user interface a window of a video player in full screen mode in response to said detecting;
> reading said video file by said player to play said video in said window;
> encoding said video file with a header and a plurality of tracks; and
> inserting plural instructions into a selected one of said tracks,
> wherein said plural instructions are readable by said player so that said player displays information in response to the instructions,
> wherein said inserting includes inserting a first instruction relating to additional video content, and said displaying in response to said first instruction includes playing said additional video content within said viewing screen prior to playing said video.

Each of independent claims 35, 68, 102, and 136 are amended to recite, among other features, said video file is encoded with a plurality of tracks, at least one of said tracks having instructions, wherein one of said instructions is a first instruction relating to additional video content, said player in response to said first instruction displaying said additional video content, and wherein said player plays

said additional video content within said viewing screen area prior to playing said video. Because the amended features were previously recited in a number of the above-cited canceled claims, Applicant will address the rejections of claims 1, 35, 68, 102, and 136 with respect to the art applied to the amended subject matter.

The references as applied in the Office Action, fail to disclose or suggest wherein said inserting includes inserting a first instruction relating to additional video content, and said displaying in response to said first instruction includes playing said additional video content within said viewing screen prior to playing said video, as similarly recited in claims 1, 35, 68, 102, and 136.

In numbered paragraph 38, for example, the PTO concedes that the combination of AAPA, *Thompson*, *Katinsky*, and *Smith* fail to disclose or suggest every feature recited in Applicants' claims, and relies on *Portuesi* in an effort to remedy this deficiency.

Portuesi discloses a system for the playback of media files. The media file includes an audio track, image track, and URL track. Each track contains information that is used to play the audio track and display the images and URLs at various locations and a various times in a media player. Each URL track is associated with another track in the movie file, and is active for a given segment of time **during playback of the movie file**. A playback application uses timing and placement information to display the URL to a user at the appropriate time. *See* Portuesi, col. 5, line 13 through col. 6, line 45.

Portuesi, however, does not disclose an embodiment in which the URL or any other video file for that matter is displayed in response to a first instruction and is

played within said viewing screen prior to playing said video. Rather, this reference discloses that the URL track is active during the playback of the movie file.

Dependent claims 26, 59, 93, and 127 similarly recite the subject matter of buffering other ones of said tracks of said video file as it is being received at said user computer while playing said additional content from said selected one of said tracks within said viewing screen. Contrary to the assertions provided in the Office Action, however, this feature is not disclosed or suggested in the applied references.

Portuesi is alleged to remedy the deficiencies of AAPA, *Thompson*, *Katinsky*, and *Smith* concerning the features recited in the above-noted dependent claims. In contrast, however, *Portuesi* discloses that the movie files are stored in a data storage device 6. *See* Id., col. 4, lines 18-22. There is no teaching or suggestion of that the described concepts and techniques are applicable for streaming video. Thus, a *prima facie* case of obviousness has not been established.

In summary, *AAPA*, *Thompson*, *Katinsky*, and *Portuesi* when applied individually or collectively fail to disclose every element and/or the combination of elements recited in Applicants' claims 1, 35, 68, 102, and 136. Upon careful review, Applicants' believe that none of the other references (e.g., *Abato*) as applied, remedy the deficiencies of *AAPA*, *Thompson*, *Katinsky*, *Portuesi*, and *Smith* such that a *prima facie* case of obviousness is established.

The Office has the initial burden of establishing a **factual basis** to support the legal conclusion of obviousness. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). For rejections under 35 U.S.C. § 103(a) based upon a combination of prior art elements, in KSR Int'l v. Teleflex Inc., 127 S.Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007), the Supreme Court stated that "a patent composed

of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art." "Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some **articulated reasoning with some rational underpinning** to support the legal conclusion of obviousness." In re Kahn, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) (emphasis added). For at least the foregoing reasons, withdrawal of all rejections under 35 U.S.C. §103 is respectfully requested.

Conclusion

Based on the foregoing amendments and remarks, Applicants respectfully submit that claims 1-11, 13-23, 26-44, 46, 47, 49-57, 59-78, 80, 81, 83-90, 93-112, 114-125, and 127-140 are allowable and this application is in condition for allowance. In the event any unresolved issues remain, the Office is encouraged to contact Applicants' representative identified below.

Respectfully submitted,

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